Remarks

This Application has been carefully reviewed in light of the Office Action mailed January 19, 2006. Applicants appreciate the Examiner's consideration of the Application. Applicants have made a clarifying amendment to independent Claim 1. This amendment is not considered narrowing or necessary for patentability. Applicants believe all pending claims are allowable over the Examiner's rejections without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

I. Allowable Subject Matter

Applicants note with appreciation the allowance of Claims 7-12, 23, and 25. Pursuant to M.P.E.P. § 1302.14, Applicants respectfully issue a statement commenting on the Examiner's reasons for allowance. Applicants respectfully traverse the Examiner's reasons for allowance to the extent that they are inconsistent with applicable case law, statutes, and regulations. Furthermore, Applicants do not admit to any characterization or limitation of Claims 7-12, 23, and 25 or to any characterization of a reference by the Examiner, particularly any that are inconsistent with the language of the claims considered in their entirety and including all of their constituent limitations.

II. The Claims are Allowable over the Proposed *Walsh-Robie* Combination

The Examiner rejects Claims 1-6, 13-18, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,810,429 B1 to Walsh, et al. ("*Walsh*") in view of "What is the Document Object Model?" by Jonathan Robie ("*Robie*").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.

Applicants respectfully submit that the Examiner has not proven a *prima facie* case of obviousness for at least two reasons. First, assuming for the sake of argument that the

Examiner has shown the requisite teaching suggestion, or motivation in the cited references to combine or modify *Walsh* with *Robie* in the manner the Examiner proposes, the proposed *Walsh-Robie* combination still fails to disclose, teach, or suggest each and every element of the claimed invention. Second, Applicants respectfully submit that the Examiner has not shown the requisite teaching, suggestion, or motivation to combine or modify *Walsh* with *Robie* in the manner the Examiner proposes.

1. Independent Claims 1 and 4 are Allowable

Independent Claim 1, which Applicants discuss as an example, recites:

> A method for outputting data from a legacy computer system, the data output in Extensible Markup Language format, the method comprising:
>
> generating a model of the legacy computer system, the model comprising one or more incidents within one or more applications of the legacy computer system that output data;
>
> mapping the model of the legacy computer system to an Extensible Markup Language schema; and
>
> based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema, automatically modifying the one or more applications of the legacy computer system that output data, the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language.

i. The Proposed *Walsh-Robie* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation recited in Claim 1

The proposed *Walsh-Robie* combination fails to disclose, teach, or suggest each and every limitation recited in Claim 1.

For example, the cited portion of *Walsh* fails to disclose, teach, or suggest "generating a model of the legacy computer system, the model comprising one or more incidents within one or more applications of the legacy computer system that output data," as recited in Claim 1. As allegedly disclosing this element of Claim 1, the Examiner cites two portions of *Walsh*. (*See* Office Action, Page 3)

The first portion of *Walsh* cited by the Examiner relates to various data mapping techniques disclosed in *Walsh*. (*See* Office Action, Page 3; *Walsh* at 11:10-30) In particular,

the Examiner references the disclosure in *Walsh* of update mapping, delete mapping, and add/create mapping, and attempts to equate these mappings with the "one or more incidents" recited in Claim 1. Yet nowhere does the cited portion of *Walsh* disclose, teach, or suggest that these update, delete, and add/create mappings are "within one or more applications of the legacy computer system," as are the one or more incidents recited in Claim 1, or that the mappings "output data," as do the one or more incidents recited in Claim 1. Additionally, the cited portion of *Walsh* does not disclose, teach, or suggest that a model that is generated of the legacy computer system comprises the update, delete, and add/create mappings.

The second portion of *Walsh* cited by the Examiner states:

> The actual generation and execution of SQL statements is performed by a separate "modeler" object. The modeler object is generated by the design tools 140. For each type of document used in the system, there is a distinct modeler object. Each modeler knows how to construct exactly one type of document. During the design process, one specifies what information is to be retrieved from the database, and how to map the information into an XML document. The design tools serialize and save the modeler objects in a ".ser" file. At runtime, the service bridge loads and de-serializes the modeler objects from the ".ser" file. The resultant modeler objects are able to perform all of the data access and mapping functions required to retrieve information from the data sources. As stated above, SQL to XML data mapping is performed by the modeler object designed for a particular document type.

(*Walsh* at 15:61-16:10; *see also* Office Action, Page 3) In particular, the Examiner highlights the alleged disclosure of "generating a model" from this excerpt of *Walsh*. (*See* Office Action, Page 3)

Whether or not *Walsh* discloses "generating a model" of some sort, as alleged by the Examiner, the mere disclosure of generating a model does not disclose, teach, or suggest the specific limitations recited in Claim 1: "generating a model of the legacy computer system, the model comprising one or more incidents within one or more applications of the legacy computer system that output data," as recited in Claim 1. "To establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art." M.P.E.P. § 2143.03 citing *In re Royka*, 490 F.2d 981 180 U.S.P.Q. 580 (C.C.P.A. 1974) (emphasis added). "***All words in a claim*** must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 citing *In re Wilson*, 424

F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added). Moreover, considering both portions of *Walsh* cited by the Examiner, those portions certainly do not disclose, teach, or suggest "generating a model of the legacy computer system, ***the model comprising one or more incidents [the update mapping, delete mapping, and add/create mapping, as asserted by the Examiner] within one or more applications of the legacy computer system that output data***," as recited in Claim 1.

As another example, at least because *Walsh* fails to disclose, teach, or suggest "generating ***a model*** of the legacy computer system, the model comprising one or more incidents within one or more applications of the legacy computer system that output data," as recited in Claim 1, *Walsh* necessarily fails to disclose, teach, or suggest "mapping ***the model*** of the legacy computer system to an Extensible Markup Language schema," as recited in Claim 1.

As another example, *Walsh* fails to disclose, teach, or suggest "based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema, automatically modifying the one or more applications of the legacy computer system that output data, the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language," as recited in Claim 1.

First, at least because *Walsh* fails to disclose, teach, or suggest "generating a model of the legacy computer system, the model comprising one or more incidents within one or more applications of the legacy computer system that output data" and "mapping the model of the legacy computer system to an Extensible Markup Language schema," as recited in Claim 1, *Walsh* necessarily fails to disclose, teach, or suggest "based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema, automatically modifying the one or more applications of the legacy computer system that output data, the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language," as recited in Claim 1.

Second, the cited portion of *Walsh* fails to disclose, teach, or suggest this element of Claim 1. It appears that *Walsh* is entirely unrelated to "***automatically modifying*** [based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema] ***the one or more applications of the legacy computer system*** that output data, ***the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language,***" as recited in Claim 1. In fact, based on the cited portions of *Walsh*, it appears that *Walsh* merely discloses converting/translating data records stored in and retrieved from the data sources (e.g., databases) and is unrelated to applications that output data. (*See, e.g., Walsh* at 15:61-16:10) *Walsh* repeatedly discusses how its system ***converts*** or ***translates*** these stored data records from a legacy format to XML. (*See, e.g., Walsh* at Abstract (stating that the integration system includes a back-end interface configured to convert input data source information to input XML documents and to convert output XML document to output data source information), 4:17-21 (stating that back-end interface 110 maps (or translates) data from legacy formats into the XML format used by enterprise integration system 100), and 5:42-44 (stating that a primary purpose of back-end interface 110 is to access legacy data and convert that data into the XML format)

Merely converting or translating stored data records from a legacy format to XML simply does not disclose, teach, or suggest "***automatically modifying*** [based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema] ***the one or more applications of the legacy computer system*** that output data, ***the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language,***" as recited in Claim 1. There simply does not appear to be any modification of any legacy application in *Walsh*; there is merely conversion/translation of stored data records in from legacy formats to XML.

As another example, the Examiner acknowledges that *Walsh*, the primary reference of the obviousness rejection, fails disclose, in the Examiner's words, "output[ing] data written using a Document Object Model from the legacy computer system in Extensible Markup Language." (*See* Office Action, Page 4) However, the Examiner argues that *Robie* discloses

these limitations. The cited portion of *Robie* merely provides its view of what the DOM is and that the DOM may be used as an API for HTML and XML documents. (*Robie* at Page 1, Paragraph 1; *see* Office Action, Page 4) *Robie*, however, fails to disclose, teach, or suggest using the DOM in the context of the limitations recited in Claim 1, particularly "automatically modifying [based at least on the mapping of the model of the legacy computer system to the Extensible Markup Language schema] the one or more applications of the legacy computer system that output data, the one or more modified applications operable to output data written using a Document Object Model from the legacy computer system in Extensible Markup Language."

ii. The Proposed *Walsh-Robie* Combination is Improper

Applicants respectfully submit that the Examiner has not shown the requisite teaching, suggestion, or motivation in either *Walsh* or *Robie*, or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, to combine or modify *Walsh* with *Robie* in the manner proposed by the Examiner. Claim 1 is allowable for at least this additional reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Walsh-Robie* combination does not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention." M.P.E.P. § 2143.01 (emphasis added). Even the fact that references can be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.***" *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet,*

[1] Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "***The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.***" M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome ***wherein that which only the invention taught is used against its teacher.***'" *In re Kotzab,* 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products,* 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, ***explaining that the required evidence of***

such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references***. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

> With respect to the proposed *Walsh-Robie* combination, the Examiner states:
>
> However, note the Robie reference (first paragraph) defining Document Object Model. It is an application programming interface (API) for HTML and XML documents, defining the logical structure of documents and the way a document is accessed and manipulated. XML presents data as documents and the DOM is used to manage the data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to consider the XML support and interfaces as disclosed by Walsh to include DOM. Walsh recognized the need (col. 2, lines 56-60) "to convey transactional data between any number of database regardless of their format, context, and access methodology.

(Office Action, Page 4)

However, these statements do not in any way provide a motivation for one of ordinary skill in the art at the time of invention to combine or modify the system disclosed in *Walsh* with the disclosure of *Robie*. In other words, the Examiner's statements do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the particular techniques disclosed in *Walsh* with the cited disclosure in *Robie*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have done so; or (3) how doing so would purportedly meet the limitations of Claim 1.

The Examiner has merely proposed a definition of the DOM from *Robie*. The Examiner has not pointed to any portions of either *Walsh* or *Robie* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the particular techniques disclosed in *Walsh* with the cited disclosure in *Robie*. It certainly would not have been obvious to one of ordinary skill in the art at the time of invention ***to even attempt*** to, let alone ***to actually***, modify or combine the particular techniques disclosed in *Walsh* with the cited disclosures in *Robie* in the manner proposed by the Examiner.[2] Applicants respectfully submit that the Examiner's attempt to modify or combine *Walsh* with *Robie* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the references fail to provide the required teaching, suggestion, or motivation to combine *Walsh* with *Robie* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants maintain that the Examiner's proposed combination of *Walsh* with *Robie* appears to be merely an attempt to reconstruct Applicants' claims, with the benefit of hindsight using Applicants' claims as a blueprint, and is unsupported by the teachings of *Walsh* and *Robie*. Applicants respectfully submit that the rejection must therefore be withdrawn.

iii. Conclusions with Respect to Claims 1 and 4

As demonstrated above, Applicants respectfully submit that *Walsh* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Robie* did disclose the portions of Claim 1 that the Examiner asserts it discloses, and even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Walsh* with *Robie* as the Examiner proposes, the proposed *Walsh-Robie* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is

[2] If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain reasons analogous to those discussed above with reference to independent Claim 1, Applicants respectfully request reconsideration and allowance of independent Claim 4 and its dependent claims.

2. Independent Claims 13 is Allowable

Walsh, whether considered alone or in combination with *Robie*, fails to disclose, teach, or suggest at least the following limitations as recited in Claim 13:

- a computer system having an application that outputs data, each data output instance corresponding to a write operation of the application; and
- wherein the application calls the writer engine when the application outputs data, the writer engine operable to build a Document Object Model instance for output of the data in accordance with the Extensible Markup Language schema.

For example, *Walsh* fails to disclose, teach, or suggest "a computer system having an application that outputs data, each data output instance corresponding to a write operation of the application," as recited in Claim 13. Instead, based on the cited portions of *Walsh*, it appears that *Walsh* merely discloses converting/translating data records stored in and retrieved from the data sources (e.g., databases) and is unrelated to applications that output data. (*See, e.g., Walsh* at 15:61-16:10) *Walsh* repeatedly discusses how its system ***converts*** or ***translates*** these stored data records from a legacy format to XML. (*See, e.g., Walsh* at Abstract (stating that the integration system includes a back-end interface configured to convert input data source information to input XML documents and to convert output XML document to output data source information), 4:17-21 (stating that back-end interface 110 maps (or translates) data from legacy formats into the XML format used by enterprise integration system 100), and 5:42-44 (stating that a primary purpose of back-end interface 110 is to access legacy data and convert that data into the XML format) Data records stored in a database simply do not disclose, teach, or suggest "a computer system having an

application that outputs data, each data output instance corresponding to a write operation of the application," as recited in Claim 13.

As another example, *Walsh* fails to disclose, teach or suggest "wherein the application calls the writer engine when the application outputs data, the writer engine operable to build a Document Object Model instance for output of the data in accordance with the Extensible Markup Language schema," as recited in Claim 13.

First, at least because *Walsh* fails to disclose, teach, or suggest "a computer system having an application that outputs data, each data output instance corresponding to a write operation of the application," as recited in Claim 13, *Walsh* necessarily fails to disclose, teach, or suggest "wherein ***the application*** calls the writer engine when ***the application outputs data***, the writer engine operable to build a Document Object Model instance for output of the data in accordance with the Extensible Markup Language schema," as recited in Claim 13.

Second, the cited portions of *Walsh* do not appear to disclose, teach, or suggest that the data sources, or databases, disclosed in *Walsh* (which the Examiner apparently equates with the application recited in Claim 13) calls any writer engine when data is queried from or output from the data source (which Applicants do not necessarily agree can even be equated with "when the application outputs data," as recited in Claim 13), let alone, any writer engine that is "operable to build a Document Object Model instance for output of the data in accordance with the Extensible Markup Language schema," as recited in Claim 13.

Moreover, as Applicants demonstrated above, the Examiner has not shown the requisite teaching, suggestion, or motivation in the either *Walsh* or *Robie*, or in the knowledge generally available to one of ordinary skill in the art to combine or modify *Walsh* with *Robie* in the manner proposed by the Examiner. Thus, Applicants respectfully submit that the Examiner's rejection based on the proposed *Walsh-Robie* combination does not

support a *prima facie* case of obviousness, as is required under the M.P.E.P. and governing Federal Circuit cases.[3] Claim 13 is allowable for at least this additional reason.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 13 and its dependent claims.

3. Independent Claim 20 is Allowable

At a minimum, *Walsh*, whether considered alone or in combination with *Robie*, fails to disclose, teach, or suggest the following limitations recited in Claim 20:

- modifying an application of the legacy computer system such that the modified application is operable to output data having a schema element of a target Extensible Markup Language schema, the output data corresponding to a write operation of the application;
- outputting data from the modified application, the output data having the schema element of the target Extensible Markup Language schema;
- aligning the schema element of the output data and a current context;
- writing the schema element of the output data to a current one of plural contexts of the target Extensible Markup Language schema; and
- populating a Document Object Model with the output data to output an Extensible Markup Language instance.

As just one example, the cited portion of *Walsh* fails to disclose, teach, or suggest "modifying an application of the legacy computer system such that the modified application is operable to output data having a schema element of a target Extensible Markup Language schema, the output data corresponding to a write operation of the application," as recited in Claim 20. As discussed above with reference to Claim 1, *Walsh* is directed to converting/translating data records stored in and retrieved from the data sources (e.g., databases) and is unrelated to applications that output data. (*See, e.g., Walsh* at 15:61-16:10). In particular, *Walsh* merely discloses converting or translating stored data records from a legacy format to XML – it is not modifying legacy computer applications, let alone, "modifying an application of the legacy computer system such that the modified application is operable to output data having a schema element of a target Extensible Markup Language

[3] If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

schema, the output data corresponding to a write operation of the application," as recited in Claim 20. In other words, the data sources disclosed in *Walsh* are not modified such that they output data having a schema element of a target Extensible Markup Language schema, the output data corresponding to a write operation of the application, as recited in Claim 20.

As another example, *Walsh* fails to disclose, teach, or suggest "outputting data from the modified application, the output data having the schema element of the target Extensible Markup Language schema," as recited in Claim 20. First, at least because *Walsh* fails to disclose, teach, or suggest "modifying an application of the legacy computer system to output data having a schema element of a target Extensible Markup Language schema, the output data corresponding to a write operation of the application," as recited in Claim 20, *Walsh* necessarily fails to disclose, teach, or suggest "outputting data from the modified application, the output data having the schema element of the target Extensible Markup Language schema," as recited in Claim 20. Furthermore, even assuming for the sake of argument only that the data sources disclosed in *Walsh* could be equated with the modified applications recited in Claim 20 (with which Applicants disagree), the data sources do not "output data having a schema element of a target Extensible Markup Language schema, the output data corresponding to a write operation of the application," as recited in Claim 20.

Moreover, as Applicants demonstrated above, the Examiner has not shown the requisite teaching, suggestion, or motivation in the either *Walsh* or *Robie*, or in the knowledge generally available to one of ordinary skill in the art to combine or modify *Walsh* with *Robie* in the manner proposed by the Examiner. Thus, Applicants respectfully submit that the Examiner's rejection based on the proposed *Walsh-Robie* combination does not support a *prima facie* case of obviousness, as is required under the M.P.E.P. and governing Federal Circuit cases.[4] Claim 20 is allowable for at least this additional reason.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 20 and its dependent claims.

[4] If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

III. Dependent Claim 19 is Allowable over the Proposed *Walsh-Robie-Vermeire* Combination

The Examiner rejects Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *Robie* and U.S. Patent 6,209,124 B1 to Vermeire, et al. ("*Vermeire*").

Claim 19 depends from independent Claim 13, which Applicants have shown above to be clearly allowable over the proposed *Walsh-Robie* combination. *Vermeire* fails to make up for the deficiencies of the proposed *Walsh-Robie* combination discussed above with reference to Claim 13. Thus, dependent Claim 19 is allowable at least due to its dependence on Claim 13. Additionally, dependent Claim 19 recites further patentable distinctions over the references cited in the Examiner's rejections. To avoid burdening the record and in view of the clear allowability of independent Claim 13, Applicants do not specifically discuss these distinctions in this Response; however, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicants do not admit that the Examiner's proposed *Walsh-Robie-Vermeire* combination is possible or that the Examiner has demonstrated the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art the time of Applicants' invention to combine or modify these references in the manner proposed.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 19.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the various references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

Conclusion

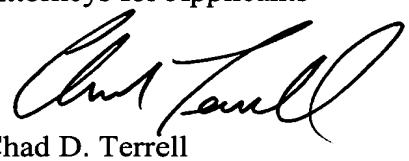
Applicants have made an earnest attempt to place this case in condition for immediate allowance. For at least the foregoing reasons, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214.953.6813.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees or to credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Chad D. Terrell
Reg. No. 52,279

Date: April 19, 2006

Customer Number: **35005**